

Under the Paperwork Reduction Act of 1995 no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PTO Form 1960 (Rev 10/2011)

OMB No. 0651-0050 (Exp 07/31/2017)

## Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
<b>SERIAL NUMBER</b>	86493241
<b>LAW OFFICE ASSIGNED</b>	LAW OFFICE 111
<b>MARK SECTION</b>	
<b>MARK</b>	<a href="http://tmng-al.uspto.gov/resting2/api/img/86493241/large">http://tmng-al.uspto.gov/resting2/api/img/86493241/large</a>
<b>LITERAL ELEMENT</b>	COOL BOX
<b>STANDARD CHARACTERS</b>	YES
<b>USPTO-GENERATED IMAGE</b>	YES
<b>MARK STATEMENT</b>	The mark consists of standard characters, without claim to any particular font style, size
<b>ARGUMENT(S)</b>	
<p>Applicant responds to the Office Action dated July 22, 2016 rejecting Applicant's arguments that its goods are so from the goods in US Trademark Registration No. 2181276 for the mark COOL BOX for a plastic storage contain household use that confusion is highly unlikely.</p> <p>Applicant submits the attached Consent to Registration signed by Mattel, Inc., the owner of the cited registration requesting that the citation of its registration be withdrawn. Applicant thus requests that the Examiner withdraw refusal under 15 USC Section 1052(d).</p> <p>TMEP Section 1207.01(d)(viii), entitled Consent Agreements, provides the following guidance:</p> <p>“Accordingly, the Court of Appeals for the Federal Circuit has indicated that consent agreements should be given great weight, and that the USPTO should not substitute its judgment concerning likelihood of confusion for the judgment of the real parties in interest without good reason, that is, unless the other relevant factors clearly indicate a finding of likelihood of confusion. See <i>In re Four Seasons Hotels Ltd.</i>, 987 F.2d 1565, 26 USPQ2d 1071 (F. Cir. 1993); <i>In re N.A.D. Inc.</i>, 754 F.2d 996, 224 USPQ 969 (Fed. Cir. 1985); see also <i>du Pont</i>, 476 F.2d at 1362, 178 USPQ at 568; cf. <i>In re Mastic Inc.</i>, 829 F.2d 1114, 4 USPQ2d 1292 (Fed. Cir. 1987) (affirming TTAB's holding).</p>	

applicant's mark was barred by §2(d), because the provided consent to register was essentially a "naked" consent. All other relevant factors weighed in favor of a conclusion that confusion was likely).

Thus, examining attorneys should give substantial weight to a proper consent agreement. When an applicant has entered into a credible consent agreement and, on balance, the other factors do not dictate a likelihood of confusion, an examining attorney should not interpose his or her own judgment that confusion is likely.

The Consent to Register submitted here is not a naked consent. Applicant draws the Examiner's attention to the following statements therein:

"After careful examination of the circumstances unique to this matter, the parties agree that the parties' respective goods are sufficiently different in several respects including, without limitation, in presentation, style, nature, purpose, and focus; and will be sold through different trade channels and to different target consumers. The goods described in the Mattel Mark are intended primarily for children to use as a small storage container for school supplies such as pens, markers, pencils, erasers, and small arts and craft supplies, and are or will be sold through school and arts and crafts stores or such departments of retail stores. The goods described in the CoolBox Application are large, multi-function hardware tool boxes and integrated workstations for use by adults (such as professional construction workers or do-it-yourself amateurs), and are or will be sold primarily through hardware stores or hardware departments of retail stores (and not through school, arts and craft supply stores or such departments of retail stores). This combination of factors and circumstances unique to these particular instances and the marks of the parties, including those factors outlined above, are such that we believe there will be no likelihood of confusion as to the source of the parties' respective goods.

Further, Mattel and CoolBox agree that they will reasonably cooperate with each other in good faith to take measures to prevent instances of future confusion in the marketplace between their respective products and services.

In light of the foregoing considerations, Mattel and CoolBox are in agreement that each company may use its respective marks now and in the future on its particular respective goods without concern that such usage will cause confusion, deception or mistake. Mattel therefore consents to the registration of the CoolBox Application and requests that the Examining Attorney withdraw the refusal against the CoolBox Application on the basis of the Mattel Mark. "

Applicant earnestly requests the withdrawal of the cited registration and believes that the application is now in a condition for publication.

Respectfully submitted,

Amy Goldsmith

## EVIDENCE SECTION

### EVIDENCE FILE NAME(S)

<b>ORIGINAL PDF FILE</b>	<a href="#">evi_1084150162-20160122134501817313_-_Mattel_Consent_to_Coolbox_01058583x</a>
<b>CONVERTED PDF FILE(S) (2 pages)</b>	<a href="#">\\TICRS\EXPORT16\IMAGEOUT16\864\932\86493241\xml9\RFR0002.JPG</a>

	<a href="\\TICRS\EXPORT16\IMAGEOUT16\864\932\86493241\xml9\RFR0003.JPG">\\TICRS\EXPORT16\IMAGEOUT16\864\932\86493241\xml9\RFR0003.JPG</a>
<b>DESCRIPTION OF EVIDENCE FILE</b>	Consent to Registration
<b>SIGNATURE SECTION</b>	
<b>RESPONSE SIGNATURE</b>	/Amy B. Goldsmith/
<b>SIGNATORY'S NAME</b>	Amy B. Goldsmith
<b>SIGNATORY'S POSITION</b>	Attorney of record, New York State bar member
<b>SIGNATORY'S PHONE NUMBER</b>	212 216-8000
<b>DATE SIGNED</b>	01/22/2016
<b>AUTHORIZED SIGNATORY</b>	YES
<b>CONCURRENT APPEAL NOTICE FILED</b>	NO
<b>FILING INFORMATION SECTION</b>	
<b>SUBMIT DATE</b>	Fri Jan 22 14:05:35 EST 2016
<b>TEAS STAMP</b>	USPTO/RFR-XXX.XX.XX.XXX-2 0160122140535467270-86493 241-55063cbac8667abff69db fd85c879b7047f0f1821a182e 37c04eca63fe5783d27b-N/A- N/A-20160122135503564685

Under the Paperwork Reduction Act of 1995 no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PTO Form 1960 (Rev 10/2011)

OMB No. 0651-0050 (Exp 07/31/2017)

## Request for Reconsideration after Final Action To the Commissioner for Trademarks:

Application serial no. **86493241** COOL BOX(Standard Characters, see <http://tmng-al.uspto.gov/resting2/api/img/86493241/large>) has been amended as follows:

### ARGUMENT(S)

**In response to the substantive refusal(s), please note the following:**

Applicant responds to the Office Action dated July 22, 2016 rejecting Applicant's arguments that its goods are so different from the goods in US Trademark Registration No. 2181276 for the mark COOL BOX for a plastic storage container for household use that confusion is highly unlikely.

Applicant submits the attached Consent to Registration signed by Mattel, Inc., the owner of the cited registration, requesting that the citation of its registration be withdrawn. Applicant thus requests that the Examiner withdraw the refusal under 15 USC Section 1052(d).

TMEP Section 1207.01(d)(viii), entitled Consent Agreements, provides the following guidance:

"Accordingly, the Court of Appeals for the Federal Circuit has indicated that consent agreements should be given great weight, and that the USPTO should not substitute its judgment concerning likelihood of confusion for the judgment of the real parties in interest without good reason, that is, unless the other relevant factors clearly dictate a finding of likelihood of confusion. See *In re Four Seasons Hotels Ltd.*, 987 F.2d 1565, 26 USPQ2d 1071 (Fed. Cir. 1993); *In re N.A.D. Inc.*, 754 F.2d 996, 224 USPQ 969 (Fed. Cir. 1985); see also *du Pont*, 476 F.2d at 1362-63, 177 USPQ at 568; cf. *In re Mastic Inc.*, 829 F.2d 1114, 4 USPQ2d 1292 (Fed. Cir. 1987) (affirming TTAB's holding that applicant's mark was barred by §2(d), because the provided consent to register was essentially a "naked" consent and all other relevant factors weighed in favor of a conclusion that confusion was likely).

Thus, examining attorneys should give substantial weight to a proper consent agreement. When an applicant and registrant have entered into a credible consent agreement and, on balance, the other factors do not dictate a finding of likelihood of confusion, an examining attorney should not interpose his or her own judgment that confusion is likely."

The Consent to Register submitted here is not a naked consent. Applicant draws the Examiner's attention to the following statements therein:

"After careful examination of the circumstances unique to this matter, the parties agree that the parties' respective goods are sufficiently different in several respects including, without limitation, in presentation, style, nature, function, purpose, and focus; and will be sold through different trade channels and to different target consumers. The goods described in the Mattel Mark are intended primarily for children to use as a small storage container for school supplies such as pens, markers, pencils, erasers, and small arts and craft supplies, and are or will be sold through school supply and arts and crafts stores or such departments of retail stores. The goods described in the CoolBox Application are large, multi-function hardware tool boxes and integrated workstations for use by adults (such as professional construction workers or do-it-yourself amateurs), and are or will be sold primarily through hardware stores and hardware departments of retail stores (and not through school, arts and craft supply stores or such departments or retail stores). This combination of factors and circumstances unique to these particular instances and the marks and goods of the parties, including those factors outlined above, are such that we believe there will be no likelihood of confusion as to the source of the parties' respective goods.

Further, Mattel and CoolBox agree that they will reasonably cooperate with each other in good faith to take reasonable measures to prevent instances of future confusion in the marketplace between their respective products and trademarks.

In light of the foregoing considerations, Mattel and CoolBox are in agreement that each company may use its respective marks now and in the future on its particular respective goods without concern that such usage will be likely to cause confusion, deception or mistake. Mattel therefore consents to the registration of the CoolBox Application and requests that the Examining Attorney withdraw the refusal against the CoolBox Application on the basis of the Mattel Mark. “

Applicant earnestly requests the withdrawal of the cited registration and believes that the application is now in condition for publication.

Respectfully submitted,

Amy Goldsmith

#### **EVIDENCE**

Evidence in the nature of Consent to Registration has been attached.

#### **Original PDF file:**

[evi\\_1084150162-20160122134501817313 . Mattel Consent to Coolbox\\_01058583xA1AB5 .pdf](#)

#### **Converted PDF file(s) ( 2 pages)**

[Evidence-1](#)

[Evidence-2](#)

#### **SIGNATURE(S)**

#### **Request for Reconsideration Signature**

Signature: /Amy B. Goldsmith/ Date: 01/22/2016

Signatory's Name: Amy B. Goldsmith

Signatory's Position: Attorney of record, New York State bar member

Signatory's Phone Number: 212 216-8000

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the owner's/holder's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the owner/holder in this matter: (1) the owner/holder has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the owner/holder has filed a power of attorney appointing him/her in this matter; or (4) the owner's/holder's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

The applicant is not filing a Notice of Appeal in conjunction with this Request for Reconsideration.

Serial Number: 86493241

Internet Transmission Date: Fri Jan 22 14:05:35 EST 2016

TEAS Stamp: USPTO/RFR-XXX.XX.XX.XXX-2016012214053546  
7270-86493241-55063cbac8667abff69dbfd85c  
879b7047f0f1821a182e37c04eca63fe5783d27b  
-N/A-N/A-20160122135503564685



January 21, 2016

Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, VA 22313-1451

RE: Consent to Registration of Trademark Application Serial No. 86/493,241  
COOL BOX (Class 20) in the Name of Coolbox, LLC

Madam:

This letter acknowledges the consent by Mattel-Mega Holdings (US), LLC, a wholly-owned subsidiary of Mattel, Inc., ("Mattel") to the registration in the United States Patent and Trademark Office of Trademark Application Serial No. 86/493,241 COOL BOX (Class 20), which has been filed in the name of Coolbox, LLC ("CoolBox"). CoolBox acknowledges its agreement with the matters stated in this letter by its signature below.

Mattel provides this consent in light of the following facts and agreements:

Mattel is the owner of U.S. Trademark Registration 2,181,276, issued August 11, 1998, for the mark COOL BOX covering a "plastic storage container for household use" in Class 21 ("the Mattel Mark").

On December 21, 2014, CoolBox filed U.S. Trademark Application Serial No. 86/493,241 for the mark COOL BOX covering "Non-metal tool boxes containing an internal removable battery, extension cord, three-way splitter, charging ports, USB ports, removable whiteboard, built-in clock, built-in lighting, built-in speakers with connectivity to personal mobile devices for use with sound transmitting systems tablet stand, cavity for tools, external handles and external wheels" in Class 20 ("the CoolBox Application"). CoolBox has adopted and is using the mark COOL BOX on and in connection with the goods covered by the CoolBox Application.

During examination of the CoolBox Application, the Examining Attorney cited the Mattel Mark as a bar to registration against the CoolBox Application. CoolBox contacted Mattel to request a Letter of Consent.

After careful examination of the circumstances unique to this matter, the parties agree that the parties' respective goods are sufficiently different in several respects including, without limitation, in presentation, style, nature, function, purpose, and focus; and will





be sold through different trade channels and to different target consumers. The goods described in the Mattel Mark are intended primarily for children for use as a small storage container for school supplies such as pens, markers, pencils, erasers, and small arts and craft supplies, and are or will be sold through school supply and arts and crafts stores or such departments of retail stores. The goods described in the CoolBox Application are large, multi-function hardware tool boxes and integrated workstations for use by adults (such as professional construction workers or do-it-yourself amateurs), and are or will be sold primarily through hardware stores and hardware departments of retail stores (and not through school, arts and craft supply stores or such departments of retail stores). This combination of factors and circumstances unique to these particular instances and the marks and goods of the parties, including those factors outlined above, are such that we believe there will be no likelihood of confusion as to the source of the parties' respective goods.

Further, Mattel and CoolBox agree that they will reasonably cooperate with each other in good faith to take reasonable measures to prevent instances of future confusion in the marketplace between their respective products and trademarks.

In light of the foregoing considerations, Mattel and CoolBox are in agreement that each company may use its respective marks now and in the future on its particular respective goods without concern that such usage will be likely to cause confusion, deception or mistake. Mattel therefore consents to the registration of the CoolBox Application and requests that the Examining Attorney withdraw the refusal against the CoolBox Application on the basis of the Mattel Mark.

Sincerely yours,

MATTTEL-MEGA HOLDINGS (US), LLC

Name: Rie Miyake

Title/Position: Assistant Secretary

Acknowledged and Agreed:

COOLBOX, LLC

DocuSigned by:  
  
FD74ED66000064F0...

Name: Christopher Stoikos

Title: Member